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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,958	08/23/2001	Jeffrey B. Williams	LUMIPO128US	1990

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EXAMINER

CHOI, JACOB Y

ART UNIT

PAPER NUMBER

2875

DATE MAILED: 04/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/935,958

Applicant(s)

WILLIAMS ET AL.

Examiner

Jacob Y Choi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5,6,8-16,19-23,25-30 and 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,6,8-16,19-23,25-30 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 12/14/2001 failed to include all of each U.S. and foreign patent papers. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 5, 6, 8-16, 19-23, 25-30, & 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al. (USPN 6,129,662).

Regarding claim 1, Li et al. discloses an optic light guide (10) for receiving light from a light source (18) and propagating light therethrough via internal reflection, the light guide having a free end (34) that emits directional light, and a sleeve surrounding the free end (Figure 1), the sleeve having an aperture axially outwardly spaced from the free end through which a beam of light from the free end passes (36), the sleeve being selectively axially movable in and out relative to the free end prior to and during use of the device to vary the distance between the aperture and the free end to vary the size of

the beam of light passing through the aperture. The functional recitation that "during use of the device to vary the distance between the aperture and the free end vary the size of the beam of light" has not been given patentable weight because it is narrative in form. In order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function, as set forth in 35 U.S.C. § 112, 6th paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279.

Regarding claim 3, Li et al. discloses a lens attached to the sleeve, the lens covering the aperture to focus the beam of light passing through the aperture by moving the sleeve in or out relative to the free end of the light guide (column 3, lines 20-35).

Regarding claim 5, Li et al. discloses a translucent or transparent protective cover surrounding the light guide (17, 42), the protective cover having a closed end that covers the free end of the light guide, the sleeve surrounding the protective cover (42) and being axially movable in and out relative to the protective cover.

Regarding claim 6, Li et al. discloses an air interface between the protective cover and the light guide (Figure 1).

Regarding claim 8, Li et al. discloses a connecting member (49, 26, 28) attached to another end of the light guide remote from the free end, the protective cover being sealed against the connecting member.

Regarding claim 9, Li et al. discloses a support member (19, 20') for supporting the light guide.

Regarding claim 10, Li et al. discloses a connecting member (49) attached to other end of the light guide remote from the free end, the support member being integral with the connecting member.

Regarding claim 11, Li et al. discloses the support member is shaped to fit a particular application.

Regarding claim 12, Li et al. discloses the support member is used to attach the light device to a patient.

Regarding claim 13, Li et al. discloses the support member is used to attach the lighting device to a surgical instrument.

Regarding claim 14, Li et al. discloses the light device is a surgical lighting device.

Regarding claim 15, Li et al. discloses the light guide is flexible, further comprising a flexible protective cover surrounding the light guide, and a malleable wire extending between a portion of the light guide and the protective cover, the malleable wire being bendable to hold the shape of the portion of the light guide once arranged in a desired position.

Regarding claim 16, Li et al. discloses a light distributor for receiving light from a light source and propagating light therethrough via internal reflection, a light emitter for receiving light propagated by the light distributor and emitting directional light from a free end of the light emitter, and a sleeve surrounding the free end of the light emitter, the sleeve having an aperture axially outwardly spaced from the free end through which the directional light from the free end is beamed, the sleeve being selectively axially

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movable in and out relative to the free end of the light emitter prior to the during use of the device, the sleeve containing a lens covering the aperture to focus the beam of light passing through the aperture by moving the sleeve and thus the lens in or out relative to the free end of the light emitter. The functional recitation that "during use of the device to vary the distance between the aperture and the free end vary the size of the beam of light" has not been given patentable weight because it is narrative in form. In order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function, as set forth in 35 U.S.C. § 112, 6th paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279.

Regarding claim 19, Li et al. discloses the light emitter also emits diffuse light along a portion of the length of the light emitter immediately adjacent the free end.

Regarding claim 20, Li et al. discloses a translucent or transparent protective cover surrounding the light emitter, the protective cover having a closed end covering the free end of the light emitter, and the sleeve surrounding the closed end of the protective cover and being axially movable in and out relative to the protective cover.

Regarding claim 21, Li et al. discloses an air interface between the protective cover and the light emitter (Figure 1).

Regarding claim 22, Li et al. discloses a connecting member attached to an end of the light distributor remote from the light emitter, the protective cover being sealed against the connecting member.

Regarding claim 23, Li et al. discloses the light emitter and the protective cover are flexible (surgical tool (20') such as, suction or suction-irrigation cannula, retractor, electrocautery device, and the like are flexible).

Regarding claim 25, Li et al. discloses a support member for supporting the lighting device.

Regarding claim 26, Li et al. discloses the support member is shaped to fit a particular application.

Regarding claim 27, Li et al. discloses the support member is attached to an associated device.

Regarding claim 28, Li et al. discloses the associated device comprises a surgical instrument.

Regarding claim 29, Li et al. discloses the light emitter is flexible, and a malleable member extends along one side only of the light emitter, the malleable member being bendable to hold the shape of the light emitter once arranged in a desired position.

Regarding claim 30, Li et al. discloses a flexible protective cover surrounding the light emitter.

Regarding claim 32, Li et al. discloses the sleeve has an outer end wall axially outwardly space from the free end containing the aperture, the aperture having a substantially smaller diameter than the inner diameter of the sleeve adjacent the outer end wall.

Response to Amendment

4. Examiner acknowledges that the applicant has amended claims 1, 3, 5, 8, 15, 16, 19, 20, 29, & 30, cancelled claims 2, 4, 7, 17, 18, 24, & 31 with out prejudice and newly added claim 32.

Response to Arguments

5. Applicant's arguments with respect to claims 1, 3, 5, 6, 8-16, 19-23, 25-30, & 32 have been considered but are moot in view of the new ground(s) of rejection.

Claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

In response to applicant's argument that reference Li et al. simply discloses a minute spacing (of Less than 0.009 inch) of the window from the light-delivery end of the fiber optic member and that it would have no effect on the size of the beam passing through the aperture, examiner believes that any minimal adjustment to the fiber optic member (free end) would have effect on the beam output size, where applicant's invention utilizes the same approach or method to vary the size of the beam of light passing through the aperture by selectively axially moving in and out the free end of the fiber optic member.

In response to applicant's amended claims disclosing "during use of the device...etc", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a

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process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Y Choi whose telephone number is (703) 308-4792. The examiner can normally be reached on Monday-Friday (10:00-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (703) 305-4939. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

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872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-7724.

JC
April 8, 2003



Sandra O'Shea
Supervisory Patent Examiner
Technology Center 2800